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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/764,293	01/19/2001	Jonathan Schull	58587.000003	8797

7590 07/28/2005

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EXAMINER

BACKER, FIRMIN

ART UNIT

PAPER NUMBER

3621

DATE MAILED: 07/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/764,293	SCHULL, JONATHAN	
	<b>Examiner</b>	<b>Art Unit</b>	
	Firmin Backer	3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 27 May 2004.
- 2a) This action is **FINAL**.      2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 58,62-81,128,132-144,146-150 and 154-194 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 58,62-81,128,132-144,146-150 and 154-194 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
	6) <input type="checkbox"/> Other: _____.

***Response to Amendment***

1. This is in response to an amendment file on May 13<sup>th</sup>, 2005. In the amendment, Claims 58, 62-81, 128, 132-141, 143, 144, 146-150 and 154-173 are amended. Claims 59-61, 82-127, 129-131, 145, 151-153 are canceled. Claims 174-194 are added. Claims 58, 62-81, 128, 132-144, 146-150, and 154-194 are pending.

***Response to Arguments***

2. Applicant's arguments with respect to claims 58, 62-81, 128, 132-144, 146-150, and 154-194 have been considered but are moot in view of the new ground(s) of rejection.

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 58, 128 and 150 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

5. Claim 58, 128 and 150 recite the limitation "producing a second instance of digital information". There is insufficient antecedent basis for this limitation in the claim since a first instance of digital information was never produced.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 58, 62-81, 128, 132-144, 146-150, and 154-194 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jones et al (U.S. Patent No. 5,363,483) in view of Endoh (U.S. Patent 5,084,790).

8. As per claims 58, 128 and 150, Jones et al teach a method/memory/computer/system usable medium for generating a variation of a digital information instance comprising providing the digital information instance, the digital information instance having a first portion of functional data used in performing a computerized function, at least one aspect of performing the function being affected by a parameter setting, and a second portion of data including at least the parameter setting; and changing the parameter setting in response to a circumstance as determined using parameter setting change data (*see abstract, column 1 lines 48-68, 5 lines 60-6 lines 59*). Jones et al fail to teach an inventive concept of producing a second instance of digital information on a first instance of digital information, the instance of digital information including the functional data and the parameter setting, the producing in response to a copying or purchasing event for the digital for the digital information. Endoh teach producing a second instance of digital information on a first instance of digital information, the instance of digital

information including the functional data and the parameter setting, the producing in response to a copying or purchasing event for the digital for the digital information (*see column 2 lines 35-3 line 56*). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the inventive concept of Jones et al to include Endoh concept of producing a second instance of digital information on a first instance of digital information, the instance of digital information including the functional data and the parameter setting, the producing in response to a copying or purchasing event for the digital for the digital information because this would have facilitate the reproduction of digital information.

9. As per claims 62-81, 132-144, 146-149, and 154-194, they are dependent of claims 58, 128 and 150 and disclosed inventive concept related to claims 58, 128 and 150. Therefore, they are rejected under the same 35 U.S.C. 103(a) rationale.

### ***Conclusion***

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. (*see for 892*).

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

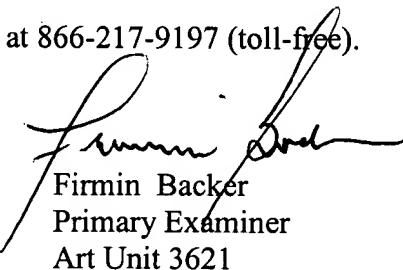
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Firmin Backer whose telephone number is (571) 272-6703. The examiner can normally be reached on Mon-Thu 9:00 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on (571) 272-6712. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Firmin Backer  
Primary Examiner  
Art Unit 3621

July 24, 2005